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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,642	10/11/2001	Robert E. Haines	10007583-1	2054

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
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EXAMINER

POND, ROBERT M

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 01/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/976,642

Applicant(s)

HAINES ET AL.

Examiner

Robert M. Pond

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

The Applicant added Claim 28-30. All pending claims 1-30 were examined in this non-final Office Action necessitated by new grounds of rejection.

Response to Arguments

Drawings

The Applicant amended the specification to overcome objections to drawings. Objection to drawings is withdrawn.

Specification

The Applicant amended the specification to overcome objections to the specification. Objection to the specification is withdrawn.

Rejection under 35 USC 103

Applicant's arguments, see Remarks, filed 08 November 2004, with respect to the rejection(s) of claim(s) 1-30 under 35 USC 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Sekizawa and Manchala. Sekizawa teaches a prior art printer system communicating directly with a vendor by transmitting a consumables purchaser order to a vendor upon reaching a predetermined level of consumables.

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Manchala teaches communicating consumables purchase orders to vendors using e-mail and operating a printer in a secure environment.

Rejection under 101

Applicant's arguments filed 08 November 2004 have been fully considered but they are not persuasive. Signals embodied in a carrier wave are non-statutory.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

- 1. Claims 21-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

If the signal claim is interpreted as an abstract arrangement "to be transmitted", or as a transmission in transit, rather than a physical signal statically embedded in a physical computer readable medium, the signal claim is considered non-statutory. A signal is insubstantial and therefore neither concrete nor tangible. It is a pattern that is evident over a period of time by measuring the changes in level of some attribute, such as voltage or current, at a given point. A signal in transmission is none of a process, machine, manufacture, or composition of matter, or any new and useful improvement thereof. It is

information transmitted as energy, encoded to endow it with intelligible patterns for subsequent interpretation.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-4, 7-11, 14-19, 21-24, 27-30 are rejected under 35 USC 103(a) as being unpatentable over Sekizawa (patent number 6,430,711), in view of Manchala et al. (Paper # 20040726, patent number 6,405,178 hereinafter referred to as "Manchala").**

Sekizawa teaches the following prior art: a) a printer as a peripheral machine consuming toner, ink, an ink ribbon, etc. (the "consumable article"), in response to its print method, b) when the remaining amount of toner, ink, etc., is low, the quality of the characters and images printed by the printer degrades, c) when the printer runs out of toner, ink, etc., it cannot print and enters a non-operational state, d) desirable to monitor the remaining amount of the consumable article to avoid entry of the machine into a non-operational state, d) Japanese Patent Number JP-A-9-188042 disclosing an example of a recorder capable of monitoring consumables, e) the recorder disclosed detecting the remaining

amount of ink, etc. falling below a predetermined value, the recorder automatically transmitting an ink purchase order to a store by fax (see at least col. 1, lines 19-35).

Sekizawa teaches all the above as noted under the 103(a) rejection and teaches a) a printer or peripheral with recorder automatically placing a purchase order when the peripheral reaches a predetermined level (please note: a threshold) of consumables, and b) transmitting the order directly to a store by fax. Sekizawa, however, does not specifically disclose e-mail ordering. Manchala teaches a) printers sending notifications of low consumables requiring replacement, b) printers sending notifications of defective components requiring replacement, and further teaches placing purchase orders with vendors using e-mail (see at least col. 4, lines 5-27). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify a prior art printer or peripheral as disclosed to transmit purchase orders using e-mail as taught by Manchala, in order to provide an alternative to fax transmission for a printer, and thereby enable a printer to transmit a purchase order via e-mail directly to a vendor.

Sekizawa teaches all the above as noted under the 103(a) rejection but does not disclose a printer with direct e-mail ordering functionality to a vendor operating within a corporate network. Manchala teaches all the above as noted under the 103(a) rejection and further teaches communications crossing firewalls, secure email, and electronic payment methods, and computer usable

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medium in the printer (see at least col. 1, lines 35-62; col. 5, lines 12-16 col. 4, lines 18-21). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify a printer or peripheral, with direct e-mail ordering functionality to a vendor, to operate within a secure computing environment as taught by Manchala, in order to communicate purchase orders directly with a vendor.

Pertaining to computer-usable medium Claims 8-11 and 14

Rejection of Claims 8-11 and 14 is based on the same rationale as noted above.

Pertaining to system Claims 15-19

Rejection of Claims 15-19 is based on the same rationale as noted above.

- 3. Claims 5, 6, 12, 13, and 20 are rejected under 35 USC 103(a) as being unpatentable over Sekizawa (patent number 6,430,711), and Manchala (Paper # 20040726, patent number 6,405,178), as applied to Claims 1, 8, and 15, further in view of Official Notice (regarding old and well known hereinafter referred to as "ON1")**

Sekizawa and Manchala teach all the above as noted under the 103(a) rejection and teach and/or suggest a) a printer communicating directly with a vendor using e-mail, b) a printer notifying an operator of a damaged disk that needs replacement service (see at least col. 1, lines 6-8, 16-20), c) the network application receiving communications from vendors regarding maintenance (see

at least col. 2, lines 59-60), and d) the printer generating an event notification to the network application pertaining to a damaged part (e.g. hard disk) needing replacement (see at least col. 4, lines 18-21). Sekizawa and Manchala, however, do not specifically disclose the printer transmitting an email to request periodic maintenance. The Examiner takes the position that it is old and well known for computer equipment and peripherals to be placed on periodic maintenance schedules as a preventative practice to minimize downtime, and thereby maximize availability to users. Therefore would have been obvious to one of ordinary skill in the art at time of the invention to disclose the printer requesting periodic maintenance or preventative maintenance as taught by ON1, in order to implement preventive maintenance practices to minimize printer downtime due to aging mechanical parts (e.g. damaged hard disk in the printer), and thereby attract users to the printer due to higher availability.

Pertaining to computer-usable medium Claims 12 and 13

Rejection of Claims 12 and 13 is based on the same rationale as noted above.

Pertaining to system Claim 20

Rejection of Claim 20 is based on the same rationale as noted above.

4. **Claims 21-24 and 27 are rejected under 35 USC 103(a) as being unpatentable over Sekizawa (patent number 6,430,711), in view of Manchala**

(Paper # 20040726, patent number 6,405,178), further in view of Official Notice (regarding old and well known, hereinafter referred to as "ON2").

Sekizawa teaches the following prior art: a) a printer as a peripheral machine consuming toner, ink, an ink ribbon, etc. (the "consumable article"), in response to its print method, b) when the remaining amount of toner, ink, etc., is low, the quality of the characters and images printed by the printer degrades, c) when the printer runs out of toner, ink, etc., it cannot print and enters a non-operational state, d) desirable to monitor the remaining amount of the consumable article to avoid entry of the machine into a non-operational state, d) Japanese Patent Number JP-A-9-188042 disclosing an example of a recorder capable of monitoring consumables, e) the recorder disclosed detecting the remaining amount of ink, etc. falling below a predetermined value, the recorder automatically transmitting an ink purchase order to a store by fax (see at least col. 1, lines 19-35).

Sekizawa teaches all the above as noted under the 103(a) rejection and teaches a) a printer or peripheral automatically placing a purchase order when the peripheral reaches a predetermined level (please note: a threshold) of consumables, and b) transmitting the order directly to a store by fax. Sekizawa, however, does not specifically disclose e-mail ordering. Manchala teaches a) printers sending notifications of low consumables requiring replacement, b) printers sending notifications of defective components requiring replacement, and further teaches placing purchase orders with vendors using e-mail (see at least

col. 4, lines 5-27). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify a prior art printer or peripheral as disclosed to transmit purchase orders using e-mail as taught by Manchala, in order to provide an alternative to fax transmission for a printer, and thereby enable a printer to transmit a purchase order via e-mail directly to a vendor.

Sekizawa teaches all the above as noted under the 103(a) rejection but does not disclose a printer with direct e-mail ordering functionality to a vendor operating within a corporate network. Manchala teaches all the above as noted under the 103(a) rejection and further teaches communications crossing firewalls, secure email, and electronic payment methods, and computer usable medium in the printer (see at least col. 1, lines 35-62; col. 5, lines 12-16 col. 4, lines 18-21). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify a printer or peripheral with direct e-mail ordering functionality to a vendor to operate within a secure computing environment as taught by Manchala, in order to communicate purchase orders directly with a vendor.

Sekizawa and Manchala teach all the above as noted under the 103(a) but do not teach embodied signal in a carrier wave. The Examiner takes the position that it is old and well known that electronic computer systems use electronic signals to operate and that digital signals are embodied in a carrier wave. Therefore it would have been obvious to one of ordinary skill in the art at time of

the invention to disclose electronic signals as taught by ON2, in order for computer systems to operate.

- 5. Claims 25 and 26 are rejected under 35 USC 103(a) as being unpatentable over Sekizawa (patent number 6,430,711) and Manchala (Paper # 20040726, patent number 6,405,178), and ON2 (regarding old and well known), as applied to Claim 21, further in view of ON1 (regarding old and well known)**

Sekizawa, Manchala, and ON2 teach all the above as noted under the 103(a) rejection and teach and/or suggest a) signal to operate, b) a printer communicating directly with a vendor using e-mail, c) a printer notifying an operator of a damaged disk that needs replacement service (see at least col. 1, lines 6-8, 16-20), d) the network application receiving communications from vendors regarding maintenance (see at least col. 2, lines 59-60), and e) the printer generating an event notification to the network application pertaining to a damaged part (e.g. hard disk) needing replacement (see at least col. 4, lines 18-21). Sekizawa, Manchala, and ON2, however, do not specifically disclose the printer transmitting an email to request periodic maintenance. The Examiner takes the position that it is old and well known for computer equipment and peripherals to be placed on periodic maintenance schedules as a preventative practice to minimize downtime, and thereby maximize availability to users. Therefore would have been obvious to one of ordinary skill in the art at time of

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the invention to disclose the printer requesting periodic maintenance as taught by ON1, in order to implement preventive maintenance practices to minimize printer downtime, and thereby attract users to the printer due to higher availability.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mr. Robert M. Pond** whose telephone number is 703-605-4253. The examiner can normally be reached Monday-Friday, 8:30AM-5:30PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Ms. Wynn Coggins** can be reached on 703-308-1344.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

Any response to this action should be mailed to:

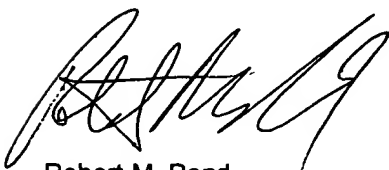
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Washington D.C. 20231

or faxed to:

703-872-9306 (Official communications; including After Final communications labeled "Box AF")

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.



Robert M. Pond
Primary Patent Examiner
January 24, 2005